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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,485	07/14/2004	Jerry W. Culpepper	72793/00019	4484
23380	7590	04/10/2006	EXAMINER	
TUCKER, ELLIS & WEST LLP 1150 HUNTINGTON BUILDING 925 EUCLID AVENUE CLEVELAND, OH 44115-1414			BUGG, GEORGE A	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/710,485	CULPEPPER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	George A. Bugg	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-10,12-17 and 19-28 is/are rejected.
- 7) ☒ Claim(s) 4,11,and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>082704 and 112105</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because they are drawn very lightly and the scanned versions are very difficult to read. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention of claims 22-28 is directed to non-statutory subject matter. The claims recite a mere program listing, i.e., only its description or expression, and descriptive material is considered nonstatutory. Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process without the computer-readable medium needed to realize the computer program's functionality, and therefore nonstatutory functional descriptive material. A suggested fix would be to add the use of the computer-readable medium to the preamble of claim 22, and/or include finite uses for the data being collected and stored. Claim 22 reads as if the data being collected is merely being stored in a memory, rather than being utilized for some purpose. A suggested fix would be to add claim language, at the end of claim 22, such as "for determining the exact location of the asset". Amendment and/or clarification are needed.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-28 are provisionally rejected on the grounds of nonstatutory double patenting over claims 1-5, and 8-12 of copending Application No. 10/710,487. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Both applications are drawn to asset locating systems utilizing cellular communication, as well as GPS, central monitoring, mapping, and reporting for tracking a stolen asset.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5-10, 12-17, 19-24, and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,509,868 B2 to Flick.

7. As for claims 1, 8, 15, and 22, applicant claims a method, a system, and a computer readable medium for asset location comprising linking a portable transmitter to an asset; initiating a cellular communication from the transmitter to a controller; communicating to the controller, primary location information, representative of a cellular area from which the communication is made; initiating a secondary location system in response to the primary location information; broadcasting secondary location information from the transmitter; and receiving secondary location information into a tracking system. Referring to Flick, column 3, lines 51-59, disclose a vehicle tracking system, or asset location system. Column 4 lines 52-63, disclose a wireless communication device, shown in Figure 2, as element 44, which may be a cellular telephone transceiver, or portable transmitter, which is linked to a vehicle or asset. Figure 2 also shows the cellular device 44, in communication with controller 40. In addition column 4, lines 30-51 teach a vehicle position-determining device 42, which may be implemented by a GPS receiver. The tracking unit 25 provides primary location information data, the location information inherently being representative of an area within the tower range. As seen in Figure 2, secondary location data, is provided to the controller 40 from the GPS 42, by way of satellites or a cellular network, as further disclosed in column 4. Secondary location info, or GPS location data, is sent to the monitoring station, or tracking system, by way of the wireless transceiver 44.



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8. With respect to claims 2, 3, 9, 10, 16, 17, 23, and 24, Flick not only teaches the use of GPS, as shown above, he discloses the use of maps, in column 11, line 65 through column 12, line 5, for finding a more finite location of the asset being tracked.

9. As for claims 5, 12, 19, and 26, Flick uses GPS, which inherently teaches the use of triangulation, or a mathematical manipulation for determining position.

10. With regard to claims 6, 13, 20, and 27, column 11, line 65 through column 12, line 10, disclose monthly subscriber fees, as well as pre-pay packages, based on cellular fees.

11. As for claims 7, 14, 21, and 28, column 17, lines 4-19, disclose direct contact of the police, and transmission of location information, to allow law enforcement to track the stolen asset.

### ***Allowable Subject Matter***

12. Claims 4, 11, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, providing all other issues are cured.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George A. Bugg whose telephone number is (571) 272-2998. The examiner can normally be reached on Monday-Thursday 9:00-6:30, and

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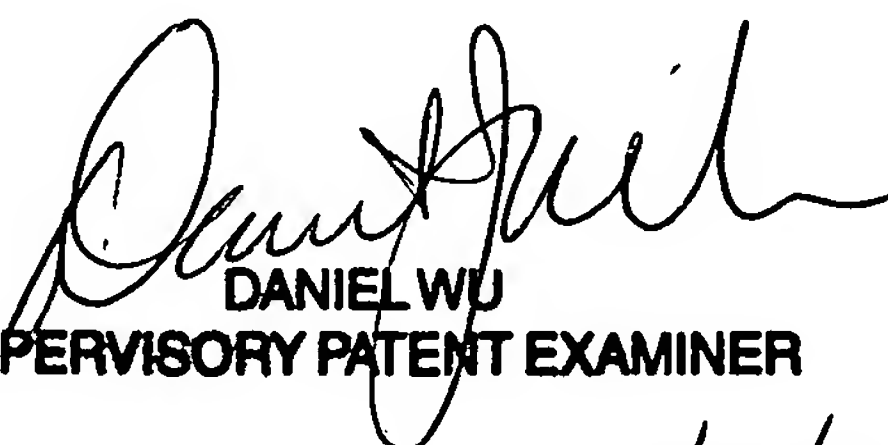
every other Friday. ***Applicant should be aware that the Art Unit Number to which this application was originally assigned has changed from 2636 to 2612.***

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

George A Bugg  
Examiner  
Art Unit 2612

March 31, 2006

  
DANIEL WU  
SUPERVISORY PATENT EXAMINER  
4/04/06